

#9



PATENT
Docket No. 10551/317

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : Jonathan S. TILL
SERIAL NO. : 10/050,879
FILED : January 18, 2002
FOR : PRESBYOPIA TREATMENT BY LENS
ALTERATION
GROUP ART UNIT : 1615
EXAMINER : Carlos A. Azpuru

OFFICE OF PETITIONS
Mail Stop DAC
Commissioner for Patents
Alexandria, VA 20231

PETITION UNDER 37 C.F.R. 1.78(a)(3)
TO ACCEPT AN UNINTENTIONALLY DELAYED CLAIM UNDER 35 USC §120

SIR:

Applicants respectfully request that the above-identified patent application be permitted to: (1) constitute, under 37 CFR 1.53(b), a continuation-in-part of, and (2) to therefore claim the benefit, under 35 USC 120 of the filing date of: the following co-pending utility application:

Serial No. 09/930,287 filed August 16, 2001.

The entire delay between the date that the claim was due under 37 C.F.R. § 1.78(a)(2)(ii) and the date of this Petition was unintentional.

Applicants respectfully request that the petition be granted and the above-identified patent application be allowed to contain the above claim to priority.

The petition fee for an unintentionally delayed claim for priority under 37 C.F.R. §1.78(a)(3) pursuant to 37 C.F.R. §1.17(t) is \$1,300.00. The Commissioner is authorized to

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charge the above fee and any additional fees, or to credit any overpayment, to Kenyon & Kenyon
Deposit Account No. 11-0600.

The Office is invited to contact the undersigned to discuss any matter regarding this
Petition.

Respectfully submitted,

Date: 11-03-03


Laleh Jalali
Registration No. 40,031

KENYON & KENYON
1500 K Street, N.W., Suite 700
Washington, D.C. 20005-1257
Tel: (202) 220-4200
Fax: (202) 220-4201

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10551/211

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : TILL, J.
SERIAL NO. : 09/930,287
FILED : Aug. 16, 2001
FOR : PRESBYOPIA TREATMENT BY LENS ALTERATION
GROUP ART UNIT : 1651
EXAMINER : LANKFORD, L.

ASSISTANT COMMISSIONER
FOR PATENTS
Washington, D.C. 20231

RESPONSE TO OFFICE ACTION

S I R:

This is in response to the Office Action mailed April 11, 2003, having a shortened statutory period for response which expires on May 12, 2003 (May 11, 2003 falling on a Sunday). Although no extension of time is deemed to be due, Applicant respectfully requests that any fees required to maintain the pendency of this application, including fees associated with an extension of time, to be charged against Deposit Account No. 11-0600 to Kenyon & Kenyon.

Please amend the specification as follows:

IN THE CLAIMS

Please cancel claims 4-6, 8-20 and 22-33 without prejudice or disclaimer to the subject matter claimed therein.

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REMARKS

Claims 1-33 are pending and are subject to restriction. Specifically, in the Office Action mailed April 11, 2003, the Examiner requested a restriction between claims 1-3, 7 and 21 (Group I), claims 4-6 (Group II), claims 8-20 (Group III) and claims 22-33 (Group IV) prior to examination. The Examiner stated that the inventions disclosed in each of Groups I through IV are distinct.

Applicant provisionally elects to prosecute claims directed to Group 1 (claims 1-3, 7 and 21) with traverse. Applicant also respectfully requests reconsideration of the restriction requirement.

The Manual of Patent Examining Procedure ("MPEP") explains the requirements for a proper restriction requirement. In particular, the MPEP states:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); *and*

(B) There must be a serious burden on the examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02).

M.P.E.P. § 803 (emphasis added).

The fact that *both* criteria must be satisfied is made clear by the following statement in the MPEP: "If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions." MPEP § 803 (emphasis added)).

Thus, if the subject matter of the pending claims is such that there would be no serious burden on the Examiner to search and examine all of the pending claims at the same time, the Examiner is to do so, *even if* the pending claims are drawn to independent or distinct inventions.

Applicant respectfully submits that the examination of Groups I, II, III and IV would not place an undue burden on the Examiner. Applicant notes that the inventions claimed in each of said groups, though independently patentable, are closely related such that a prior art search directed to one group could reveal art directed to both groups of claims. Thus, it is respectfully submitted that the Examination of Groups I through IV would not pose an undue burden on the Examiner.

For at least these reasons Applicant respectfully requests reconsideration and withdrawal of the restriction requirement.

CONCLUSION

If any point remains that is deemed best resolved through a telephonic interview, the Examiner is respectfully invited to contact the undersigned attorney.

Respectfully submitted,

Date: May 1, 2003

Dianoosh Salehi

Dianoosh Salehi
(Reg. No. 46,352)

KENYON & KENYON
1500 K Street, N.W., Suite 700
Washington, DC 20005
Tel: (202) 420-4200
Fax: (202) 420-4201

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/930,287

08/16/2001

Jonathan S. Till

10551-211

9371

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04/11/2003

KENYON & KENYON
1500 K STREET, N.W., SUITE 700
WASHINGTON, DC 20005

EXAMINER

LANKFORD JR, LEON B

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 04/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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OFFICE OF PETITIONS





Office Action Summary

Application No.

09/930,287

Applicant(s)

TILL, JONATHAN S.

Examiner

L Blaine Lankford

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

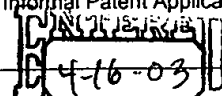
- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:



DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 - 3, 7 and 21, drawn to a method for reversing presbyopia, classified in class 435, subclass 183, for example.
 - II. Claims 4 - 6, drawn to a method for increasing amplitude of accommodation in a human eye, classified in class 424, subclass 78.04, for example.
 - ✓ III. Claims 8 - 20, drawn to a method for treating presbyopia, classified in class 424, subclass 94.1, for example.
 - ✓ IV. Claims 22 - 33, drawn to a composition, classified in class 424, subclass 94.5, for example.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions IV:I, IV:II and IV:III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown:
 - (1) the process for using the product as claimed can be practiced with another materially different product or
 - (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)).In the instant case the methods for treating and/or reversing presbyopia could be accomplished with laser,

the method for increasing amplitude of accommodation could be practiced with surgical methods.

The inventions of groups I:II, I:III and II:III are directed to different inventions which are not connected in design, operation, and/or effect. These methods are independent since they are not disclosed as capable of use together, they have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the various methods at the same time to practice just one method alone.

The several inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches (as indicated by the different classification). The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group.

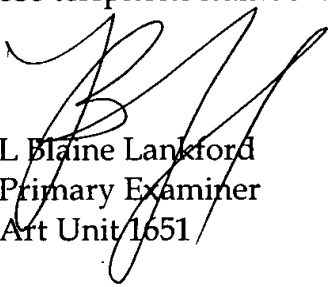
Because these inventions are distinct for the reasons given above and the search required for one group is not required for the other groups, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to L Blaine Lankford whose telephone number is 308-2455. The examiner can normally be reached on Mon-Thu 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0196.



L Blaine Lankford
Primary Examiner
Art Unit 1651

LBL
March 24, 2003



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UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,287	08/16/2001	Jonathan S. Till	10551-211	9371

23838 7590 07/16/2003

KENYON & KENYON
1500 K STREET, N.W., SUITE 700
WASHINGTON, DC 20005

EXAMINER

LANKFORD JR, LEON B

ART UNIT PAPER NUMBER

1651

DATE MAILED: 07/16/2003



Please find below and/or attached an Office communication concerning this application or proceeding.

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OFFICE OF PETITIONS

Office Action Summary



Application No.

09/930,287

Applicant(s)

TILL, JONATHAN S.

Examiner

L Blaine Lankford

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

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Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,7 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,7 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

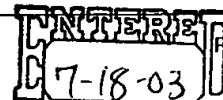
- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
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- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
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- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.



DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of group I in Paper No. 8 is acknowledged.

The traversal is on the ground(s) that there is no burden on the examiner. This is not found persuasive because the search required is different and the literature search extensive.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 1 & 21 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 21 & 1 of this application.

Claim 1 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 21. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 7 & 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of the instant procedure are not clearly claimed.

Localized energy is to be applied but there is no indication of how and why to do so. Applicant should clearly claim the effect of the applied energy. Please note that the language of a claim must make it clear what subject matter the claim encompasses to adequately delineate its "metes and bounds". See, e.g., the following decisions: In re Hammack, 427 F 2d. 1378, 1382, 166 USPQ 204, 208 (CCPA 1970); In re Venezia 530 F 2d. 956, 958, 189 USPQ 149, 151 (CCPA 1976); In re Goffe, 526 F 2d. 1393, 1397, 188 USPQ

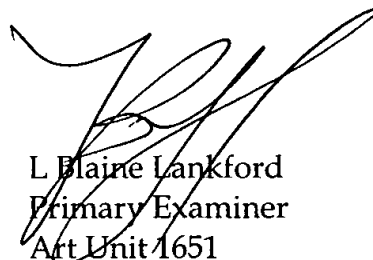
Art Unit: 1651

131, 135 (CCPA 1975); In re Watson, 517 F 2d. 465, 477, 186 USPQ 11, 20 (CCPA 1975); In re Knowlton 481 F 2d. 1357, 1366, 178 USPQ 486, 492 (CCPA 1973). The courts have also indicated that before claimed subject matter can properly be compared to the prior art, it is essential to know what the claims do in fact cover. See, e.g., the following decisions: In re Steele, 305 F 2d. 859, 134 USPQ 292 (CCPA 1962); In re Moore 439 F 2d. 1232, 169 USPQ 236 (CCPA 1969); In re Merat, 519 F 2d. 1390, 186 USPQ 471 (CCPA 1975).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to L Blaine Lankford whose telephone number is 308-2455. The examiner can normally be reached on Mon-Thu 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0196.



L Blaine Lankford
Primary Examiner
Art Unit 1651

LBL
July 14, 2003